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HAROLD B. WILLEY, Clerk

IN THE

Supreme Court of the United States

OCTOBER TERM, 1954.

No. 748

MALL TOOL COMPANY,

Petitioner,

vs.

BORG-WARNER CORPORATION,

Respondent.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT.

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PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT.

Petitioner prays that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the Seventh Circuit, entered in the above-entitled case on November 17, 1954.

CITATIONS TO OPINIONS BELOW.

The memorandum opinion of the district court (R. 313-328) is reported in 120 F. Supp. 514. The opinion of the Court of Appeals (App., pp. 1-12) is reported in 217 F. 2d 850. The petition for rehearing was denied without opinion (App., p. 13). The opinion of the Court of Appeals denying the motion to reopen judgment (App., pp. 15-20) is as yet unreported.

JURISDICTION.

The judgment of the Court of Appeals for the Seventh Circuit was entered on November 17, 1954 (Cert. R.). Rehearing was denied on January 18, 1955 (Cert. R.; App., p. 13). The time for filing a petition for a writ of certiorari was extended to June 17, 1955, by order dated March 30, 1955 (App., p. 14). A motion to reopen judgment was denied by order dated April 6, 1955 (Cert. R.). The jurisdiction of this Court is invoked under 28 U.S.C., Section 1254 (1).

QUESTIONS PRESENTED.

1. Does the doctrine that the claim measures the grant and determines its validity still impose limits on the doctrine of equivalency?

A. Can a patent claim be valid which describes nothing more than an old device in the same art, even though the old device functions in a different way than the device disclosed in the patent specification?

B. Does a finding by the Court that an old device in the same art functions in a different manner from the device described in the patent specification relieve the Court of the necessity of examining each claim of the patent which it upholds, to see if the claim actually defines anything different from the old device?

C. Has the doctrine that the claim measures the grant become so devitalized that a patent can now be upheld on the basis of an invention derived from the specification despite the fact that such invention is not defined by the particular claims held valid and infringed?

D. Can patent claims be valid which have been construed so broadly as to cover the mere use of an old kind of saw tooth on a different type of saw where the

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saw tooth in the new use performs the same cutting functions it had always performed?

2. Does a deliberate course of conduct by a patent applicant, short of restricting claims by amendment, which shows a definite intention to accept a monopoly with a specific limitation, estop the applicant from ignoring this same limitation in asserting that a device infringes because it is a mechanical equivalent of the patented device?

3. Can a court hold that infringement exists solely on the basis of equivalency where the accused device completely omits one of the elements of the patentee's combination, no element being substituted for the omitted element and the remaining elements being unchanged; and where the patentee taught the public that the omitted element was essential to the invention?

4. Is evidence of the inherent operation of an old device inadmissible to prove anticipation merely because the old device is disclosed in the drawings of a patent issued by a foreign country?

STATUTES INVOLVED.

"The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention."

(35 U. S. C., Section 112, second paragraph; 66 Stat. 798.)

"A person shall be entitled to a patent unless—

* * * * *

"(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, * * *"

(35 U. S. C., Section 102, in part; 66 Stat. 797.)

STATEMENT.

A. The Case in Brief.

This litigation involves Hassler patent No. 2,326,854, which issued August 17, 1943 and is entitled "Method and Means for Sawing Wood", although relating mainly to chain saws (R. 344-353; App., pp. 49-58, Abst. Hassler Pat.). As can be seen in Figure 12 of the patent drawing, Hassler's chain saw was made up of pairs of blade-like side cutting teeth, each pair followed by pairs of L-shaped bottom cutting teeth and a drag tooth. All of the teeth are supported on pivotally-connected links. In operation the side walls of the saw groove or kerf are defined by the side cutting teeth, while the kerf bottom is formed by the lateral toe portions of the L-shaped teeth. The vertical shanks of the L-shaped teeth follow in the path of the side cutting teeth, but do no cutting themselves (App., p. 53). The drag teeth carry the severed sawdust or wood chips through and out of the kerf.

The Hassler patent contains eighteen claims, which break down generally into two groups. The first group, including Claims 1 and 2, is directed to a chain saw in which certain links provide slicing elements having transverse bottom routing edges, such as those found on the toe portions of Hassler's L-shaped teeth, and other links provide side cutters having cutting edges lying at the marginal edges of the saw chain, such as the cutting edges on Hassler's blade-like teeth. The other group, including Claims 9, 10, 13, and 14, relates specifically to L-shaped saw teeth (App., pp. 56-58).

The Borg-Warner Corporation, owner by assignment of the Hassler patent brought suit under 28 U. S. C., Section 1338(a), in the United States District Court for the Northern District of Illinois, Eastern Division, against

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the Mall Tool Company. After a non-jury trial before the Honorable John P. Barnes, a judgment was entered September 24, 1953, which held in substance that defendant's commercial chain saws did not infringe any valid claims of the patent. Specifically, the trial court held the saw teeth Claims 9, 10, 13 and 14 invalid, and the chain saw combination Claims 1 and 2, as well as Claims 11 and 12, valid if limited to a chain saw having separate side and bottom cutting teeth, and therefore infringed only by models which defendant had manufactured in limited numbers but never sold (R. 336, 335, 28-29). Defendant's commercial chain saws which were held non-infringing are typified by its Square Chisel Chain and its Side Planer Chain, which contain only L-shaped cutting teeth (App., pp. 61, 62).

Plaintiff appealed the adverse judgment (except as to claims 11 and 12) to the United States Court of Appeals for the Seventh Circuit, pursuant to 28 U. S. C., Section 1292(4) (R. 337). Defendant did not cross appeal. By opinion dated November 17, 1954, the Court af Appeals affirmed the holding that Claims 9, 10, 13 and 14 were invalid, but reversed the holding below that Claims 1 and 2 could not be construed to cover defendant's commercial chain saws without making these claims invalid (App., pp. 1-12).

A petition for rehearing was filed December 2, 1954, which the Court of Appeals considered on four briefs (App. pp. 21-48), and denied by order dated January 18, 1955 (App., p. 13). On February 16, 1955, defendant filed a motion to reopen based on newly discovered evidence. This motion was heard on briefs, affidavits, and exhibits, and denied by opinion dated April 6, 1955 (App., pp. 15-20).

B. Detailed Statement.

1.

A chain saw is a machine used principally for commercial lumbering. It includes an endless flexible chain made up of links riveted together and carrying a series of cutting elements or saw teeth. It also includes an engine to drive the saw chain, and a guide bar around which the chain travels. Chain saws of this general construction have been known for many years (App., pp. 63, 64; R. 412-417, 450-452). The general sawing art is of course even older.

Both the trial judge and the Court of Appeals found that L-shaped saw teeth, covered by Claims 9, 10, 13 and 14 of the patent, were known long before Hassler (App., pp. 9-12), and for this reason held these claims invalid. The trial judge also refused to construe Claims 1 and 2 to cover anything more than Hassler's specific combination of cutting elements which included the separate side cutters, because in his view the enlarged claims would lack invention (R. 326). If broadly construed, among other things, Claims 1 and 2 would cover the mere substitution of an old type of saw tooth on a different variety of saw, which the trial judge thought did not rise to the dignity of invention. The Court of Appeals disagreed, holding that Claims 1 and 2 could validly cover chain saws, like defendant's commercial products, which use only L-shaped cutting teeth (App., pp. 6-8). This result was apparently based mainly on the finding:

> "* * * that the essential novel feature contributed by Hassler in his chain saw combination was an L-shaped tooth having both its shank and lower horizontal edge sharpened so as to cut off and under the wood fibers, respectively, leaving the debris behind to be pulled away by a drag element following the tooth, thus preventing clogging, which had been so troublesome in earlier devices." (App., p. 3.)

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Defendant had previously contended and again urged in its Petition for Rehearing that Claims 1 and 2 are not expressly limited to L-shaped teeth, and that consequently their validity cannot be supported on the basis of a finding like that made by the Court of Appeals. On the other hand, defendant urged that Claims 1 and 2 *are* expressly limited to chain saws having separate side cutting teeth.

Claim 1, which can be taken as typical of both claims reads:

> "1. In a chain saw, a plurality of pivotally joined links, *certain of said links* having formed thereon angularly disposed slicing elements extending from one marginal edge of said chain saw towards the longitudinal center line of said chain saw, said slicing elements having transverse, bottom routing edges formed thereon, said slicing elements being arranged in pairs oppositely disposed and spaced laterally apart, and *others of said links* having formed thereon side cutters having cutting edges lying at the marginal edges of said chain saw." (R. 352; App., p. 56; italics added.)

Defendant pointed out to the Court that the "bottom routing edges" mentioned in Claims 1 and 2, might or might not be provided by L-shaped teeth, whereas other claims in the patent contain a precise designation of L-shaped teeth. (See App., pp. 56-58, Hassler Pat. Claims.) On the other point of construction, defendant stressed the specific recitation in Claims 1 and 2 that the bottom routing edges are formed on "certain of said links" while the side cutting edges are formed on "others of said links."

The Court of Appeals, however, adopted a broad construction of Claims 1 and 2, and held that infringement existed despite the fact that defendant's chain saws lacked separate side cutting teeth. At the same time, the Court treated Claims 1 and 2 as if they recited "L-shaped" teeth in order to save them from invalidity.

On the infringement issue, the Court quoted with approval plaintiff's contention that:

> "* * * since every tooth of the accused structures includes a slicing element and a side cutter, it follows, necessarily, that some of the teeth have slicing elements and others side cutters, and that, thus, the language as well as the spirit of the claims is satisfied in the accused structures." (App., p. 6.)

On the validity issue, the Court did not discuss the relationship of Claims 1 and 2 to the invention which it attributed to Hassler. Instead, the Court merely stated that:

> "* * * the defendant cannot escape infringement of Claims 1 and 2 by any of the exhibits submitted, for the reason that they are equivalents of what Hassler prescribed * * * [T]he language of each claim is broad enough to include the devices complained of and the latter employ, if not in exactly the same form, the underlying invention of Hassler." (App., p. 7.)

As a further reason why Claims 1 and 2 could not be valid if construed broadly, defendant repeatedly urged that a broad construction of these claims made them read literally on an earlier chain saw (App., p. 69, Shipe Pat. Drawing; App., p. 70, charts). Plaintiff never at any time pointed out any language in these claims distinguishing from the chain saw of the Shipe patent. The issue in plaintiff's view was whether the earlier chain saw was functionally equivalent to the one described in Hassler's patent. Plaintiff contended that if it was not, the doctrine of equivalency saved the claims from invalidity, despite the lack of language distinction (App., pp. 21-48).

The Court of Appeals regarded the Shipe chain saw as functionally non-equivalent to Hassler's chain saw (App., pp. 8-9). In denying the Petition for Rehearing, the Court of Appeals must have accepted plaintiff's legal doctrine

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that a patent claim need not distinguish a non-equivalent prior-art device. There is no evidence that the Court itself made any examination of Claims 1 and 2 to see if they actually defined anything different from Shipe's chain saw.

2.

In rejecting defendant's contention that Hassler had deliberately accepted a limited monopoly which if recognized would have precluded a holding of infringement, the Court of Appeals stated:

> "Despite any terminology employed by Hassler in presenting his case, an examination of his claims and specification indicate a sharp divergence from anything that Shipe taught." (App., p. 8.)

This willingness to overlook what Hassler said and did while obtaining his patent amounts to a reversion to the narrow estoppel rule announced in *Bassick Co.* v. *Faultless Caster Corp.*, 105 F. 2d 228, 231 (C. A. 7, 1939); following *Spalding & Bros.* v. *John Wanamaker*, 256 Fed. 530 (C. A. 2, 1919). These cases hold that an estoppel must be based on the restriction of broader claims by amendment. Other circuits hold that an estoppel may also arise from other conduct. *e.g.*, *Godfrey L. Cabot, Inc.* v. *J. M. Huber Corp.*, 127 F. 2d 805, 807 (C. A. 5, 1942).

The estoppel issue revolves around Hassler's deliberate use of the terms "certain" and "others" in Claims 1 and 2 to describe his arrangement of cutting edges in a chain saw and to distinguish this arrangement from that found in the old chain saw of Shipe (App., pp. 59-60). As has already been mentioned, Claims 1 and 2 recite that the bottom routing edges are formed on "*certain* of said links" while the side cutting edges are formed on "*others* of said links" (App., pp. 56, 57). These terms provide a definite language distinction from Shipe's chain saw, only if con-

strued as requiring that the side cutting edges are on separate links from the bottom cutting edges (App., p. 70).

Shipe's chain saw has side cutting edges and bottom cutting edges fully responding to the definition of Claims 1 and 2 except that both types of cutting edges are provided on the same links (App., p. 69), rather than the bottom cutting edges being on certain links and the side cutting edges on other links as in Hassler's arrangement (App., p. 59). When the terms "certain" and "others" are read to mean, *all links having both types of edges*, as was done by the Court of Appeals to bring defendant's commercial products within the claims, then the only language distinction from Shipe's chain saw is obliterated and these claims describe nothing more than an old device (App., p. 70).

Claims 1 and 2 were first presented during the prosecution of Hassler's patent application at a time when the Shipe patent was not before the Patent Examiner (App., pp. 59-60). Subsequently, Hassler himself called the Shipe patent to the attention of the Patent Examiner and made it a file wrapper reference, stating:

> "In order that the record may be complete as far as applicant is concerned, applicant calls attention to Shipe 323,602." (App., p. 59.)

At the same time Hassler pointed out, among other things:

> "Shipe 323,602 had the idea he could combine in a single element, slitting elements and routing elements * * *." (App., p. 60.)

In other words, Hassler was telling the Patent Examiner that his chain saw differed from Shipe's in that Shipe's had both the side cutting edges ("slitting elements") and the bottom cutting edges ("routing elements") combined into a single cutting element, as compared with his ar-

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rangement where the bottom cutting edges were on "certain" links and the side cutting edges on "other" links.

Hassler stressed in his patent the alternating or sequential cutting action which resulted from the separately spaced side and bottom cutting edges (App., pp. 50-53, italicized portions). He made a parallel representation directly to the Examiner before Claims 1 and 2 were allowed (App., p. 59). Moreover, the concept of a chain saw having both side cutting and bottom cutting edges on the same links is completely absent from Hassler's specification.

The Court of Appeals dismissed all this as "terminology employed by Hassler in presenting his case," and then construed Claims 1 and 2 broadly with respect to the critical terms "certain" and "others". Thus, the factual elements of estoppel were ignored.

3.

The nub of the case for the Court of Appeals was the finding that defendant's commercial chain saws functioned similarly to Hassler's chain saw (App., pp. 4-5, 7). The trial court also accepted this finding, but reached a decision on this issue of infringement contrary to the decision by the Court of Appeals,

> "* * * because no separate side cutting teeth, devoid of laterally extending toes, are embodied in Plaintiff's Exhibits 1, 2, 3, 4 or 5, they do not infringe claims 1 and 2." (R. 326.)

After referring to the above quotation, the Court of Appeals stated:

> "In reaching this conclusion we think the Court was misled into the belief that though the same result was accomplished by defendant, the elimination of one component prevented defendant's devices from

being the equivalents of Hassler's. Our language, in *Sears Roebuck & Co.* v. *Delta Mfg. Co.*, 78 F. 2d 745 (C. A. 7) is pertinent: * * * 'One does not escape infringement by providing a single element which fully responds to a plurality of elements in the patent.' (Citing cases.) To the same effect is *Apex Electrical Mfg. Co.* v. *Maytag Co. et al.*, 122 F. 2d 182 (C. A. 7). In *Graver Mfg. Co.* v. *Linde Co.*, 339 U. S. 605, at 608, the Court quoted with approval from an earlier case as follows: 'if two devices do the same work in substantially the same way, and accomplish the same result, they are the same, even though they differ in name, form, or shape.'" (App., pp. 5-6.)

On this issue, the essential facts are brought out by comparing defendant's Square Chisel chain (App., p. 61), for example, with Hassler's chain (App., p. 49). The Square Chisel chain contains only L-shaped cutting teeth and is completely devoid of separate side cutters. Further, the L-shaped teeth on the Square Chisel chain have the same configuration as Hassler's bottom cutting teeth. Thus, it is apparent that a chain saw substantially identical to defendant's Square Chisel chain can be produced by cancelling off the side cutting teeth on Hassler's chain, as indicated on the marked copy of Hassler's Fig. 12 (App., p. 49).

As already discussed, there is not the slightest suggestion in Hassler's patent specification that the separate side cutting teeth could be completely omitted. Instead, Hassler repeatedly emphasized the importance of first defining the kerf's side walls with the separate side cutting teeth and then cutting the bottom wall (App., pp. 50-53). In Claims 1 and 2 he defined the side cutters and bottom cutters as separate elements. The Court of Appeals, however, construed these claims as covering what would remain of Hassler's chain saw after all side cutters were removed.

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4.

Defendant's motion to reopen was based on certain foreign patents of Serin, consisting principally of his British Patent No. 176,363 of 1922 and the three additions to his French Patent No. 532,069 (App., pp. 67, 68). This motion was denied on the ground that allegedly anticipating foreign patents are in a radically different category from prior American patents (App., pp. 15-20). In so holding, the Court relied on *Carson* v. *American Smelting and Refining Co.*, 4 F. 2d 463, 465 (C. A. 9, 1925).

The *Carson* case was interpreted by the Court of Appeals as forbidding any elaboration or clarification of foreign patent drawings by way of demonstrations or expert testimony. Summarizing this view, the Court stated:

> "We must conclude either that defendant reads into these illustrations [certain figures of the British and French Serin patents] a broader concept than that which the patentee envisioned, or that the illustrations disclose a teaching broader than the claims and written specifications of the patent to which they are attached. Either alternative is fatal to defendant's position. *Carson* v. *American Smelting & Refining Co., supra.*" (App., p. 20.)

In its original opinion, the Court of Appeals stressed the broad novelty in Hassler's chain saw of the flow of chips over the bottom cutting edges and back beneath the links of the chain (App., pp. 2-3). This mode of operation was distinguished from that of Shipe's chain saw which "forced the debris directly through the links and out of the device." (App., pp. 8-9.) The Serin patents not only contain illustrations of chain saws which would operate like Shipe's but also contain other chain saw illustrations which defendant contended would inherently operate like Hassler's chain saw (App., pp. 67, 68). Defendant offered to prove its contention by the demonstra-

tion of working models and expert testimony with respect to the models, and asked that the case be reopened to permit this explanatory evidence to be introduced. The Court stated that the rule of the *Carson* case did not permit the introduction of evidence to show that foreign patent drawings disclose something that is not expressly stated in the patent itself.

A motion to reopen on the ground of newly discovered evidence involves a question of diligence. Defendant therefore submitted an affidavit to demonstrate its diligence, and also filed a formal offer to compensate plaintiff for injuries due to any lack of diligence with which it was properly chargeable (App., p. 16).

The Court of Appeals expressly declined to rule on the diligence issue, and the Court did not decide whether defendant's formal offer would cure a lack of diligence if it existed. The Court relied solely on its interpretation of the law relating to foreign patents as the basis for denying the motion to reopen (App., pp. 16, 20).

REASONS FOR GRANTING THE WRIT.

A. Summary.

1.

This case involves a novel question of fundamental importance to the administration of the patent system by both the federal courts and the United States Patent Office. The question is basically whether the doctrine of equivalency defined by this Court as a guide in determining infringement in *Graver Tank and Mfg. Co.* v. *Linde Air Products Co.*, 339 U. S. 605 (1950) is to be extended to eliminate the rule that the scope of patent protection should be measured by the patent claims, as restated in *Graver Tank and Mfg. Co.* v. *Linde Air Products Co.*, 336 U. S. 271, 277 (1949).

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The Court of Appeals relied on the doctrine of equivalency to the exclusion of the latter rule. It dismissed the old chain saw of Shipe solely on the basis that it was functionally non-equivalent to Hassler's chain saw in spite of the evident fact that Claims 1 and 2 as broadly construed described Shipe's old device in all particulars and were therefore invalid. No finding was made that Claims 1 and 2 are distinguished in any way from Shipe's device.

The rule that the claims must define the invention in clear structural terms and thereby distinguish it from the prior art has been a basic axiom of the United States patent system. *Grant* v. *Walter*, 148 U. S. 547 (1893); *Altoona Publix Theatres* v. *American Tri-Ergon*, 294 U. S. 477, 487 (1935); *Graver Tank and Mfg. Co.* v. *Linde Air Products Co.*, 336 U. S. 271, 277 (1949); 35 U. S. C., Section 112, second paragraph. This rule is the principal basis of the Examining procedure in the Patent Office. See *Manual of Patent Examining Procedure* (2d. Ed. 1953), Sections 608.01 (o), 706.02, 707.07 (d), 714.02, 904.01, etc. Claims cannot be allowed by the Patent Office even though the patent application discloses inventive subject matter unless the claim definition itself describes something more than the prior art. *In re Thuau*, 135 F. 2d 344 (C. C. P. A., 1943).

If a court were free to uphold the validity of a claim which fails to make any distinction between the subject matter of the patent and a prior art device, patent claims would become completely superfluous, as would the lengthy claim examining and amending procedure in the Patent Office. The claim would no longer measure the grant as required by *Graver Tank and Mfg. Co.* v. *Linde Air Products Co.*, 336 U. S. 271, 277 (1949); nor would the claim inform the public of the exact metes and bounds of the granted monopoly. See *United Carbon Co.* v. *Binney and Smith Co.*, 317 U. S. 228, 236 (1942); *General Electric* v.

Wabash Appliance, 304 U. S. 364, 369 (1938). The conclusion is inescapable that the Court of Appeals has exceeded its authority to the detriment of the patent system and the public interest.

2.

The decision of the Court of Appeals on the issue of infringement in this case constitutes a radical departure from Supreme Court law which has been well settled for nearly a century. The Court of Appeals in this case concluded that infringement can be found on a theory of mechanical equivalency even though one element of the patentee's combination is *completely omitted* without the actual substitution of any equivalent element. This ruling is directly contrary to *McClain* v. *Ortmayer*, 141 U. S. 419 (1891), and *Rees* v. *Gould*, 82 U. S. 39 (1872). The vitality of *McClain* v. *Ortmayer* was recently reaffirmed in *Graver Tank and Mfg. Co.* v. *Linde Air Products Co.*, 336 U. S. 271 (1949). The Supreme Court should exercise its supervisory authority so that the doctrine of infringement by equivalents will continue to be confined within its proper and well accepted boundaries.

3.

This case presents an opportunity for the Supreme Court to clarify the law of estoppel in patent cases. The law of estoppel in the various circuits is confused and conflicting. The Second Circuit, for example, has consistently held that a patentee is not estopped from asserting a broadened construction of his claims for infringement purposes because the construction is inconsistent with statements and arguments that had been presented to the Patent Office. *Spalding and Bros.* v. *John Wanamaker*, 256 Fed. 530 (C. A. 2, 1919). The Seventh Circuit tends to follow the same rule, *Bassick* v. *Faultless Caster*

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Corp., 105 F. 2d 228, 231 (C. A. 7, 1919), although there have been some apparent departures, *Thomas* v. *Simmons Co.*, 126 F. 2d 743 (C. A. 7, 1942). The Fifth Circuit definitely accepts the broader rule that an estoppel can be based on statements alone without any restrictive amendment. *Godfrey L. Cabot, Inc.* v. *J. M. Huber Corp.*, 127 F. 2d 805, 807 (C. A. 5, 1942). Other circuits look to statements and arguments made to the Patent Office as evidence of the patentee's concept of his invention, and then construe the claims in accordance with the inventive concept thus determined. *Modern Products Supply Co.* v. *Drachenberg*, 152 F. 2d 203, 207 (C. A. 6, 1945); *Allen-Bradley Co.* v. *Erie Resistor Corp.*, 104 F. 2d 150, 151-152 (C. A. 3, 1939).

In *Exhibit Supply Co.* v. *Ace Patents Corp.*, 315 U. S. 126, 136 (1942), this Court held that the doctrine of equivalents could not be relied on to recapture subject matter which had been excluded from a claim by restrictive amendment. The Supreme Court, however, has not as yet ruled on the question of the effect to be given to statements made in the papers submitted to the Patent Office. This Court should act to resolve the conflicts in practices of the circuits.

4.

In denying the motion to reopen, the Court of Appeals based its decision on a legal doctrine which discriminates against foreign patents contrary to the applicable statute. The Court expressly held that a defendant in a patent suit is barred from relying on the inherent method of operation of a prior art device just because it is found in a foreign rather than a domestic patent, stating that it was following *Carson* v. *American Smelting and Refining Co.*, 4 F. 2d 463, 465 (C. A. 9, 1925). 35 U. S. C. 102 (b) does not permit such a distinction. Under this statutory

provision the anticipatory effect of United States and foreign patents are the same.

The doctrine of the *Carson* case is an anachronism in American patent law which should be eradicated. See *Dewey & Almy Chemical Co.* v. *Mimex Co.*, 124 F. 2d 986, 990 (C. A. 2, 1942), for comment by Judge Learned Hand. Instead, the decision below in this suit has carried the *Carson* case doctrine to unprecedented heights. The Supreme Court should end this non-statutory discrimination against foreign patents.

B. Discussion.

This case presents the ominous spectre of equivalency running rampant. Acting under a sweeping concept of equivalency as the primary if not the sole desideratum in a patent suit, the Court of Appeals held claims valid which read squarely on the prior art, overrode a clear estoppel against the broadened claim construction which it adopted, and then went on to hold infringement by structures which completely omitted an essential element of the patentee's combination. Conversely, the same Court denied defendant the opportunity to prove that a prior art device inherently functions in a manner equivalent to the patentee's device just because the prior art device was shown in a foreign patent.

Such an approach to the issues involved in patent suits certainly benefits the patent owner, but the benefits are awarded at the expense of the public. If equivalency is to be paramount and all else subsidiary or irrelevant, the public would rarely be able to determine from the face of a patent the exact monopoly area which it covers. The only reliable criteria of infringement would be prolonged and expensive litigation in the course of which the federal courts would have to assume the duties now performed

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by the Patent Office. See *Claude Neon Lights, Inc.* v. *E. Machlett & Sons,* 36 F. 2d 574, 575-576 (C. A. 2, 1929), for a discussion of this subject by Judge Learned Hand.

This is not to say that there should be no doctrine of infringement by equivalents and we are not suggesting that the holding on rehearing in the *Graver* case be reconsidered. *Graver Tank and Mfg. Co.* v. *Linde Air Products Co.,* 339 U. S. 605 (1950). Neither are we merely asking for a review of that portion of the first *Graver* opinion which reaffirmed the rule that the claim measures the grant. *Graver Tank and Mfg. Co.* v. *Linde Air Products Co.,* 336 U. S. 271, 277 (1949). Indeed the Court of Appeals in this suit felt constrained to follow the express decision of the first *Graver* case in holding claims 9, 10, 13, and 14 invalid.

Stated broadly, the questions presented by this petition all involve important aspects of the relationship between the doctrine of equivalency and the rule that the claim measures the grant, which were not dealt with in either of the *Graver* opinions. The present suit offers a unique opportunity for clarifying each of the basic questions raised by this petition, both individually and in relation to the general structure of patent law doctrines.

1.

For all its broad language, the majority opinion on rehearing in the *Graver* case was obviously not intended to make new law. The Supreme Court had reaffirmed the doctrine that the claim measures the grant in its first opinion in that case. Moreover, on rehearing the majority expressly assumed the conclusive validity of the claims in issue. 339 U. S. at 607.

Thus, the *Graver* rehearing decision can give no comfort to those who would seek to use the doctrine of equiv-

alents to create the validity of a claim as well to test its infringement. This, however, is essentially what the Court of Appeals did in the present suit, and primarily on the basis of its view of the *Graver* rehearing decision. The validity of Hassler's Claims 1 and 2 as broadly construed was literally *created* by the dismissal of Shipe's chain saw as functionally non-equivalent, even though Shipe's device was fully described and not distinguished by the language of these claims.

It might be observed that the present decision by the Court of Appeals is a striking fulfillment of Justice Black's prediction in his dissenting opinion on the rehearing of the *Graver* case, where he objected particularly to the language of the majority opinion.

> "One need not be a prophet to suggest that today's rhapsody on the virtue of the 'doctrine of equivalents' will, in direct contravention of the Miller case (U. S.) supra, make enlargement of patent claims the 'rule' rather than the 'exception'."
>
> (*Graver Tank and Mfg. Co.* v. *Linde Air Products Co.*, 339 U. S. 605, 616 (1950), Justice Black dissenting.)

As brought out in petitioner's Statement, the construction of Hassler's Claims 1 and 2 which was adopted by the Court of Appeals in upholding these claims makes them fully and accurately descriptive of Shipe's old chain saw (App., p. 70). This construction is glaringly inconsistent with the established rule that the claims must measure the grant. *Grant* v. *Walter*, 148 U. S. 547 (1893); *Altoona Publix Theatres* v. *American Tri-Ergon*, 294 U. S. 477, 487 (1935); *Graver Tank and Mfg. Co.* v. *Linde Air Products*, 336 U. S. 271, 277 (1949).

The rule that the claim must measure the grant is based on statute as well as on the decisions of this Court. As stated in the Patent Act of 1952,

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"The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention."

(35 U. S. C., Section 112, second paragraph.)

Clearly, the quoted statutory provision forbids sustaining patent claims which apply to the prior art as well as to the patentee's device. If Congress had intended that compliance with 35 U. S. C., Section 112 could be waived with respect to any category of prior art devices it would have so provided in the statute.

2.

The Court of Appeals held that defendant's commercial products did not avoid infringing Claims 1 and 2 even though these products completely omitted one element of Hassler's combination; namely, the separate side cutting teeth (App., pp. 5-7). The Court's decision on this point carried the doctrine of infringement by equivalents further than ever before. The two lower court cases relied on by the Court of Appeals do not on the facts support its position.

In *Sears, Roebuck & Co.* v. *Delta Mfg. Co.*, 78 F. 2d 745 (C. A. 7, 1935), the infringer actually substituted a new and different element from any which the patentee disclosed. Instead of the two separate clamps described by the patentee, the infringer used a specially-constructed clamping device which was adapted to perform the functions of both of the separate clamps in the patentee's structure. In the present case defendant has substituted nothing for any element described by Hassler. The separate side cutting teeth, which Hassler thought were essential to his combination, have been entirely omitted.

Neither does *Apex Electrical Mfg. Co.* v. *Maytag Co.*,

122 F. 2d 182 (C. A. 7, 1941), hold that infringement can be shown where an element of the patentee's combination has been omitted without the substitution of an equivalent element. In the *Apex* case one multi-purpose lever was actually substituted for the two levers described by the patentee.

In *Graver Tank and Mfg. Co.* v. *Linde Air Products Co.*, 339 U. S. 605 (1950), also cited by the Court of Appeals, a well known chemical equivalent (manganese silicate) was substituted for the alkaline earth metal silicates specified in the claims. In such situations there is a definite element of evasion—an equivalent is *substituted*—giving rise to something akin to practicing a fraud on a patent as stated in the majority opinion. When nothing is substituted, however, the equitable basis of the doctrine of equivalency is lacking. How can it amount to a fraud on a patent to simply omit something which the patentee taught was essential?

The Court of Appeals' holding on the issue of infringement herein is directly contrary to *McClain* v. *Ortmayer*, 141 U. S. 419 (1891), and *Rees* v. *Gould*, 82 U. S. 39 (1872). The correct rule on the present facts is well stated in *McClain* v. *Ortmayer* (recently reaffirmed in the first *Graver* opinion) where the infringer had completely omitted one of the two springs described by the patentee in combination with his horse collar.

> "While a single spring or hook embracing the fore wale of a collar may be equally as efficacious, the patentee is no more at liberty to say that the spring encircling the after wale is immaterial and useless than was the patentee in *Vance* v. *Campbell* to discard one of the elements of his combination upon the same ground."

Hassler now wishes to discard his separate side cutting teeth as immaterial and useless. This is forbidden by

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the legal doctrine of *McClain* v. *Ortmayer* and it has no equitable basis. If Hassler knew that his separate side cutting teeth were really unnecessary, he should have told the public this in his patent instead of proclaiming the contrary.

3.

What a patentee said and did during the process of obtaining his patent is a matter of public record. The complete file of any application which matures into a patent can be inspected on request at the Patent Office, or photostatic copies thereof can be obtained at a nominal charge. Further, most attorneys specializing in the practice of patent law regularly obtain and study these so-called file wrappers. The problem, however, is to what extent can the public and the patent bar rely on the content of a patent application file wrapper in determining whether the issued patent forecloses a proposed course of business activity.

The most serious problem relates to the legal effect of file wrapper statements, representations, and arguments by which a patentee disclaims certain broad constructions of his claims, without actually amending the claims themselves. Since the present suit involves such a factual situation, we commend its consideration by the Supreme Court as a means of harmonizing the law of "file wrapper estoppel" in the unsettled area beyond *Exhibit Supply Co.* v. *Ace Patents Corp.*, 315 U. S. 126, 136 (1942).

4.

We say that any distinction between the anticipatory effect of foreign and domestic prior art patents is expressly contrary to statute, notwithstanding the doctrine

of *Carson* v. *American Smelting and Refining Co.*, 4 F. 2d 463, 465 (C. A. 9, 1925). 35 U. S. C. 102 provides in part:

> "A person shall be entitled to a patent unless—
>
> • • • • •
>
> "(b) the invention was patented or described in a printed publication *in this or a foreign country* * * * more than one year prior to the date of the application for patent in the United States * * *." (Italics added.)

This statutory provision precludes treating foreign patents or publications any differently from domestic patents or publications. Indeed, in the usual course of events foreign patents become publications which are available domestically.

The result reached by the Court of Appeals on the motion to reopen is not even supported by the *Carson* doctrine as previously applied.

In the *Carson* case, evidence about the operation of the prior devices described in the foreign patents was actually received and considered, although it was given little weight because based on *ex parte* tests, 4 F. 2d at 465-466. This contrasts sharply with the refusal by the Court of Appeals to give the present defendant the opportunity to make *inter partes* courtroom demonstrations for the purpose of establishing that certain of Serin's chain saws function in a manner equivalent to Hassler's.

If the Court's extension of the *Carson* doctrine is to be the law it should apply to plaintiffs and defendants alike. It is doubtful if the Seventh Circuit would so apply it, in view of *Donner* v. *Walgreen Co.*, 44 F. 2d 637, 640 (N. D. Ill., 1930). Judge Lindley, the author of the opinion being reviewed, then a district judge, there permitted experimental evidence to be introduced by a plaintiff to show what was *not* inherent in the disclosure of a foreign

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patent. In fact, he held that the foreign patent failed to anticipate on the basis of the evidence about inherent results.

We think such evidence should always be received in behalf of either party to a patent suit. It certainly should not be barred by a discriminatory rule against foreign patents which directly contravenes the applicable statute.

CONCLUSION.

For the foregoing reasons, this petition for a writ of certiorari should be granted.

Respectfully submitted,

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